

REMARKS

In the Office Action dated March 8, 2007, the Examiner rejects all pending claims under 35 U.S.C. §101 and 35 U.S.C. §112, ¶6. For the reasons stated below, Applicants respectfully disagree and submit the claims, as currently pending, are patentable.

Amendments

Claim 14 has been cancelled. Claim 27 has been added, reciting the limitations of claim 14, which was previously a dependent claim, as an Independent claim. Claims 6 and 22 have been amended to correct a typographical error.

Rejection of claims under 35 U.S.C. §101

Claims 6-9, 14-18 and 22-26 not claiming a “tangible” result

Regarding claims 6, 15 and 22, (and subsequent dependent claims 7-9, 16-18 and 23-26), the Examiner rejects these claims under 35 U.S.C. §101 as not producing a “tangible” result. The Examiner’s reasoning indicates that “searching” is not the result of a process, but rather is an intermediate step, to which Applicants must respectfully disagree.

A reading of the *Overview of Interim Guidelines for Subject Matter Eligibility*, as well as more governing MPEP sections of 2106 provide the basis for the Examiner’s position. Although, Applicants must respectfully disagree because the Examiner’s interpretation of the Examination Guidelines are inconsistent with 35 U.S.C §101.

It is well understood that the MPEP is not applicable law, but rather to provide mere guidelines for the Examiners in examining and prosecuting patent

applications. Although, provisions of the MPEP are based in law by virtue of recitation to regulations (37 C.F.R.), statutes (35 U.S.C.) and caselaw. The first rejection appears to be governed, in principle, under MPEP §2106(IV)(C)(2)(B)(2)(b). This Examination Guideline indicates that “the tangible requirement does require that the claim must recite more than a 35 U.S.C. 101 judicial exception, that the process claim must set forth a practical application of that judicial exception to product a real-world result. *Benson*, 409 U.S. at 71-72.” This is misleading to the present application and non-applicable because the claimed invention of claims 6, 15 and 22 are **not** judicial exceptions, but rather fall within the 4 enumerated categories of 35 U.S.C. §101.

The final sentence of the MPEP passage indicates that “the opposite meaning of ‘tangible’ is ‘abstract,’” which appears to govern the present rejection because the Examiner states that the “produced result remains in the abstract and, thus, fails to achieve the required status of having real world value.” (§ 4 of the present Office Action)

Applicants must respectfully disagree because the limitation, when taken into context is not an abstract feature or element. Rather, for example, claim 6 recites “A method for ranking records of a database located during a search of an index to the database ...” The final step of this limitation is conducted during the search and hence produces the tangible results of refining the search by “searching the index using query terms corresponding to index entries having weights higher than the low weight.”

Based on the Examiner’s omission of claims 10-12 and 19-21 from the present rejection, Applicants disagree with the Examiner’s interpretation of the limitation of “tangible” as being required to produce a result that is specifically presented to a user.

The Examination Guidelines¹ indicate that the result needs to be more than simply a thought and Applicants submit that refining a search result operation as indicated above is not simply a thought, but rather a tangible result within the computational framework of the claimed invention. Therefore, application of the “tangible” requirement of 35 U.S.C. §101 is improper as applied to claims 6, 14 and 22, as well as the applicable dependent claims. It is also provisionally noted that the same position applies to newly added claim 27.

Claims 6-12, 14-26 not claiming a “concrete” result

Claim 6-12 and 14-26 are rejected under 35 U.S.C. §101 as not claiming a concrete result. Similar to the “tangible” requirement, the “concrete result” requirement is described in the next MPEP section, MPEP §2106(IV)(C)(2)(B)(2)(c). The guidelines relate to whether the operations are “substantially repeatable.”

Applicants must respectfully disagree with ¶ 4 of the present Office Action because the claim would absolutely produce repeatable results and the user “falling out” out of the algorithm is not applicable. Under the recited limitations, if the methodology is repeated using the same parameters, the methodology will produce the same result because the guiding parameters are the same for each iteration. A concrete result would not be obtained if the exact opposite were true, such that running the methodology with same parameters two different times would produce two different results, and that is not the case at hand.

Regarding “falling out” of the algorithm, this ignores the context of the claim language itself. The four corners of the claim language produce the concrete result

¹ Applicants realize that the Examination Guidelines have no patentable weight, but are offered herein for supporting the “interpretation” and not for defining the term “tangible.”

and recite limitations for steps in the event the determination step determines that there are no records yet to be located that may achieve a score that is higher than the score of any of the records already located and stored in the ranking list based upon query terms corresponding to index entries having a low weight. The Examiner's position in ¶ 4 is based on language **not** recited in the limitation and hence is improper.

Therefore, application of the "concrete" requirement of 35 U.S.C. §101 is improper as applied to claims 6, 14 and 22, as well as the applicable dependent claims. It is also provisionally noted that the same position applies to newly added claim 27.

Claim 14 not claiming a tangible result

Claim 14 has been cancelled, therefore this rejection is moot. Regarding claim 27, claim 27 recites "A computer readable medium..." and therefore the rejection is not applicable.

Rejection of claims under 35 U.S.C. §112, ¶2

Claims 6-12 and 14-26 stand rejected under 35 U.S.C. §112, ¶2 as being indefinite in view of the recitation of the term "low." Applicants respectfully disagree because the specification provides proper guidance for the distinction between the terms "low" and "higher than the low."

By way of example, ¶¶ 330-334 describe weighting words between high and low weights. By way of further example, ¶¶ 344-351 describe weighting operations down in the sample of Top 500 entries. There exist additional descriptions within the specification to properly and adequately support the distinction of the claimed limitation of a "low" weight.

More specifically, the present rejection indicates that “the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.” Applicants must respectfully disagree. Based on the recited limitations claimed herein and the specification, one of ordinary skill in the art would be able to adequately and properly determine what constitutes “index entries having a low weight,” especially as claimed in relation ‘to index entries having weights **higher than** the low weight.” At the very least, the recited limitation’s relativity is defined relative to the defined limits of “the score of any of the records already located and stored in the ranking list,” and “higher than the low weight.” Therefore, the claimed invention recited in claims 6, 15 and 22 (as well as newly added claim 27) and the corresponding dependent claims is definite. As such the rejection of these claims under 35 U.S.C. §112, ¶2 is improper.

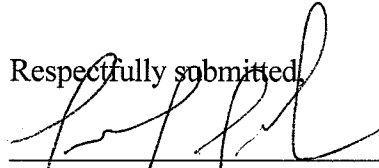
In view of the foregoing amendments and remarks, Applicants believe that the present application is now in condition for allowance, and allowance of all the pending claims is respectfully solicited. To expedite prosecution of this application to allowance, the Examiner is invited to call the Applicant's undersigned representative to discuss any issues relating to the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required or credit any overpayment to our Deposit Account No. **50-4026**.

Dated: July 9, 2007

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Respectfully submitted,



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